

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/800,285
Filed: March 12, 2004
Applicant(s): David W. Farchmin
Title: Juxtaposition Based Machine Addressing
Art Unit: 2445
Examiner: William J. Goodchild
Docket No.: 110003.00026.03AB047

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Remarks

Applicant respectfully requests consideration of the following remarks in connection with a Pre-Appeal Brief Request for Review. This paper accompanies a Notice of Appeal, a Pre-Appeal Brief Request for Review, and is being submitted before the filing of an Appeal Brief. Applicants respectfully assert that the legal requirements for establishing a prima facie case of obviousness have been misapplied in all of the rejections contained within the Final Office Action mailed on April 9, 2010. In addition, the Final Office Action mischaracterizes the asserted references. Accordingly, a Pre-Appeal Brief Request for Review is appropriate given the clear error and mischaracterizations made in the present case. In view of the following remarks, Applicants respectfully request the issuance of a Notice of Allowance for the pending claims 54 and 56-73.

In view of the Advisory Action mailed July 21, 2010, the claims stand as follows: claims 54 and 56-73 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dolin, Jr., (US 5,519,878), and further in view of Richardson et al., (US 5,644,494). Claims 62 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dolin-Richardson as applied to claim 54, and further in view of Metcalf, (US Pub. 2002/0131446). Applicant respectfully traverses these rejections based on clear misapplication of the applicable legal requirements and mischaracterizations of the asserted references.

Regardless of the specific combination of these references, the rejections are improper for at least some basic reasons. Namely, the MPEP clearly states that if a proposed modification or combination of prior art would change the principle operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious (see MPEP 2143.01(VI)). In the present case, if Dolin and Richardson were to be combined as suggested by the Examiner, Dolin's process would not be needed and therefore the combination would clearly change principle operation of Dolin's invention. To this end, Dolin recognizes that it may be important that the physical location of a switch 105 to control a light 101 be near the light (see col. 3, lines 51-62). Here, instead of

providing a general rule set regarding relative positions of resources that need to communicate (e.g., a switch and a light), Dolin relies on general knowledge of a system configurator applied during a configuration process to overcome the problem of specifying communication between improperly positioned resources. In Dolin, during system configuration, as devices (e.g., a light, a switch, etc.) are physically installed in a facility, tags identifying the devices are applied to a paper copy of the facility floor plan. Thereafter, the tags are read from the paper plan and are associated with specific positions in the facility via selection of specific positions on an electronic version of the floor plan. Next, while viewing the electronic version of the floor plan that includes a spatial representation of resources/devices within the facility, devices that will communicate with each other (e.g., a switch may be associated with a light) are selected by the configurator and associated via the electronic floor plan.

Thus, in Dolin, the configurator applies general knowledge about which switch should be used to control a light based on the spatial relationship of the switch and the light on the electronic display screen. If there were a rule set indicating probable resource positions as well as a way to automatically compare actual resource positions to the rule set, Dolin's entire process would not be needed. Instead, the configurator could simply configure Dolin's system without tags and without a paper copy and could specify communication between a switch and a light without much care as to relative juxtapositions and then the system could simply identify any portion of the configuration inconsistent with the rule set. In effect, Dolin's entire process would not be needed. Based on the MPEP section cited above, because combining Richardson with Dolin as suggested by the Examiner would change the principle operation of Dolin, the combination cannot render the claims of the present application obvious.

In response, the Advisory Action identifies col. 4, lines 22-41 of Dolin, and asserts that a floor plan with positions of nodes relates to a rule set as positions are determined. The rule set as disclosed in the instant application is clearly described as a spatial based rule set adopted by a facility or enterprise. The rule set is used in the operation of the facility, and is referred to for decision making steps (see [0150] through [0152]). The Advisory Action is incorrectly equating the general knowledge of a system configurator applied during a configuration process of a floor plan with node positions to the rule set for decision making purposes as taught in the present application.

Second, each of pending independent claims 54, 63 and 65 in this application requires, among other things, a method for validating likely correct resource communications. Neither Dolin nor Richardson teaches or suggests a method to validate likely correct resource communications. To this end, as indicated in the 12/15/2009 response to Office Action, Richardson teaches a controller that controls a printing system where all printer components are linked to the controller and there is no concept of incorrect linkage or invalid communications. Dolin teaches a system for specifying communications between system components and once specified, there is no additional process that calls for verification of validity of resource communications. Thus, because neither reference teaches or suggests a process for validating likely correct resource communications, not surprisingly, the combination of Dolin and Richardson cannot teach or suggest this purpose.

In response, the Advisory Action indicated that this requirement (validating likely correct resource communications) is located within the preamble and is intended use. Yet, the steps of the method do just that, they validate communications between resources based on a set of rules. The Advisory Action

also identifies col. 7, lines 32-65 of Dolin, and asserts that Dolin teaches validation of communications over the network. It appears as though the Advisory Action is attempting to equate Dolan's description of node addresses or network addresses with validating communications between resources. Dolan is describing nothing more than well known network addressing. There is no validation of communication between system components, and more importantly, there is no validating communications between resources based on a set of rules.

Third, the Office Action cobbles together different steps from two references (Dolin and Richardson) that are in completely different fields of art in an impermissible manner. In this regard, Dolin is related to configuring resources while Richardson is related to controlling resources that move with respect to each other to perform a process. In Dolin, as explained above, resources are stationary once positioned and the positions are only used during a commissioning process to associate resources together for control purposes. In contrast, Richardson's resources move during performance of a process and their positions need to be known as fundamental inputs to the process being performed. Combining the teachings of Richardson regarding position determination during a dynamic process with those of Dolin where resources are stationary is absurd at best.

In response, the Advisory Action indicated that Dolin discloses configuring devices in an automated environment, and Richardson in the same field of endeavor discloses adjusting devices in an automated manner. The titles of Dolin and Richardson are reflective of their field of endeavors. Dolin's title is "System for Installing and Configuring (Grouping and Node Address Assignment) Household Devices in an Automated Environment." Richardson's title is "Printing System." Applicant respectfully disagrees that Dolin and Richardson are in the same field of endeavor, and that one of ordinary skill in the industrial automation art would look to a high volume printing application focused on moving parts for guidance.

Applicant is clear that Dolin fails to teach or even remotely suggest the step of providing a rule set including rules that indicate probable relative resource positions. In this regard, Dolin teaches that a user specify actual resource positions with respect to a facility, not probable relative positions of resources with respect to each other. Regarding Dolin's col. 7, lines 32-65, Dolin teaches that node subsets can be predetermined such as devices operating in a particular area or room, etc. Here, where node groups are predefined, the predetermined groups simply operate as a way to categorize a subset of nodes and have nothing to do with probable relative resource positions. For example, in Dolin, where a facility includes several rooms including a first room, it is possible that one, ten, five, etc., lights may be placed in the first room and those lights can be grouped together and associated as a group with the room. Here, various numbers of lights may be placed in the room so that lights in the room are possible but there is no suggestion about probabilities. In other words, in Dolin it is just as likely that one light will be placed in a room as it is that twenty lights will be placed in the room and there are no rules regarding probabilities of positions.

While Richardson may teach readjustment of the position of a resource that is not in a desired position, again, it makes no sense to combine the teachings of Richardson with Dolin where Dolin's resources are purposefully placed at their actual positions by a configurer and the configurer is applying his own general knowledge to confirm that the resources are correctly positioned. In short, in Dolin all positions are possible (probabilities are not contemplated) and therefore it would make no sense to add a step whereby actual positions are compared with relative positions specified by a rule set as the rule set includes all positions.

Claim 59 requires that the entire process of claim 54 be performed in real time as resources are added to the resource subset. Richardson teaches a system that is completely configured and fails to teach or suggest that additional resources are added to the system or that if resources are added, that locations are compared in real time to probable positions specified by rules. Dolin also fails to teach these limitations.

In response, the Advisory Action asserts that Dolin (in combination with Richardson) discloses that the process is accomplished in real time, as the user can add as many resources as desired, and again identifies col. 4, lines 22-41 of Dolin for support. As discussed above, this reasoning is based on the incorrect assertion that populating a floor plan with node positions is the same as a rule set for decision making. In addition, this reasoning fails to address the fact that the claim calls for the comparison in real time to probable positions specified by rules.

Claim 68 requires, among other things, providing an information device, determining the location of the information device in a space and using a processor to automatically identify resources to be positioned at the location of the information device. Thus, for instance, an information device may include a hand held device with a display screen as an output device. Here, when a user moves the hand held device to a location within a facility space, the system automatically identifies resources to be positioned at the location.

While Dolin teaches an interface device, nothing in Dolin teaches or suggests determining the location of the information device or using a processor to automatically identify resources to be placed at the location. The Office Action cites sections of Dolin that teach determining locations of resources that communicate with each other, not the location of an information device followed by identifying resources to be placed at the location of the information device.

In response, the Advisory Action asserts that Dolin discloses the location of the information device, as there is an associated IP address, and the device is connected to the network, and again identifies col. 4, lines 22-41 of Dolin for support. This makes no sense. If the device has an IP address and it is connected to the network, how does this equate to determining the location of the device in a space? If an IP address of a printer on a network is known, sure a print job can be sent to it, but that does not tell you where the printer is located in a space. Something else needs to be done to determine the location of the printer. Dolin, alone or in combination with Richardson, fails to teach this feature and fails to make any such location determination.

Claim 71 requires that the information device includes a display and wherein the step of identifying the tags includes providing a list of the tags and the step of indicating one of the tags includes selecting one of the tags from the list. Thus, combining the claim 71 and 68 limitations, at a minimum, the claim requires determining the location of an information device that includes a display. The only device in Dolin that includes a display is the device that generates the electronic map and clearly Dolin fails to teach or suggest determining the location of that device.

In response, the Advisory Action asserts that Dolin discloses a display, and Dolin discloses a list of tags and selecting a tag, and identifies col. 4, lines 29-35 of Dolin for support. The Advisory Action failed to address that the claim requires determining the location of an information device that includes a display. It is clear that neither Dolin (nor Richardson) teach or suggest determining the location of an information device that includes a display (i.e., Dolan's device that generates the electronic map).

It is noted that the Advisory Action provided no response to Applicant's arguments provided in section 4A and 4B of the Response filed on June 8, 2010.

Applicant respectfully requests your help in overcoming these rejections to avoid burdening the Appeals Board. Applicant has introduced no new matter in making the above remarks. The above comments are applicable to each of claims 54, 63 and 65 and claims that depend there from. The Applicant submits that claims 54 and 56-73 of the present application recite patentable subject matter deserving of a timely notice of allowance. No additional fees beyond the fees authorized in the accompanying Notice of Appeal are believed due to enter this Pre-Appeal Brief Request for Review; however, if an additional fee(s) is/are required, please charge Deposit Account No. 17-0055 in the amount of the fee.

Respectfully submitted,

David W. Farchmin

Date: August 23, 2010

By: /thomas j. krumenacher/
Thomas J. Krumenacher
Reg. No. 56,098
Attorney for Applicant
Quarles & Brady LLP
411 E. Wisconsin Avenue
Milwaukee WI 53202-4497
Phone: (414) 277-5199